



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/824,226

04/14/2004

Dany Sylvain

7000-341

6350

27820 7590 01/16/2008
WITHROW & TERRANOVA, P.L.L.C.
100 REGENCY FOREST DRIVE
SUITE 160
CARY, NC 27518

EXAMINER

PHAN, MAN U

ART UNIT

PAPER NUMBER

2619

MAIL DATE

DELIVERY MODE

01/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/824,226

Applicant(s)

SYLVAIN, DANY

Examiner

Man Phan

Art Unit

2619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 12-16, 18-21 and 30-34, 36 is/are rejected.
- 7) ☒ Claim(s) 4-11, 17, 22-29 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment and Argument

1. This communication is in response to applicant's 10/30/2007 Amendment in the application of Sylvain for an "Adaptive dialing" filed 04/14/2004. The amendment and response have been entered and made of record. Claims 1-36 are pending in the application.

2. Applicant's amendment and argument to the rejected claims are insufficient to distinguish the claimed invention from the cited prior arts or overcome the rejection of said claims under 35 U.S.C. 102 and 103 as discussed below. Applicant's argument with respect to the pending claims have been fully considered, but they are not persuasive for at least the following reasons.

3. The reference of record - Hirsbrunner et al. (US#6,999,770) is a U.S. patent or U.S. patent application publication of a pending or patented application that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the patent may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

4. In response to Applicant's argument that the reference does not teach or reasonably suggest the functionality upon which the Examiner relies for the rejection. The Examiner first emphasizes for the record that the claims employ a broader in scope than the Applicant's disclosure in all aspects. In addition, the Applicant has not argued any narrower interpretation of the claim limitations, nor amended the claims significantly enough to construe a narrower meaning to the limitations. Since the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is required to interpret the claim limitations in terms of their broadest reasonable interpretations while determining patentability of the disclosed invention. See MPEP 2111. In other words, the claims must be given their broadest reasonable interpretation consistent with the specification and the interpretation that those skilled in the art would reach. See *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000), *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999), and *In re American Academy of Science Tech Center*, 2004 WL 1067528 (Fed. Cir. May 13, 2004). Any term that is not clearly defined in the specification must be given its plain meaning as understood by one of ordinary skill in the art. See MPEP 2111.01. See also *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003), *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003). The interpretation of the claims by their broadest reasonable interpretation reduces the possibility that, once the claims are issued, the claims are interpreted more broadly than justified. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). Also, limitations appearing in the specification but not recited in the claim are not read into the claim.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the failure to significantly narrow definition or scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims in parallel to the Applicant in the response and reiterates the need for the Applicant to distinctly define the claimed invention.

Since no substantial amendments have been made and the Applicant's arguments are not persuasive, the claims are drawn to the same invention and the text of the prior art rejection can be found in the previous Office Action. Therefore, the Examiner maintains that the references cited and applied in the last office actions for the rejection of the claims are maintained in this office action.

Claim Objections

5. Claims 1-2, 4, 11-12, 17 are objected to because of the following informalities: The claims contains the phrase "*adapted to*". It has been held that the recitation that an element is "*adapted to*" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled

the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 1, 18 and 19, 36 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hirsbrunner et al. (US#6,999,770).

Regarding claim 1, Hirsbrunner disclose in Fig. 2 a block diagram of a wireless communication unit arranged for facilitating selective hairpinning of a call in the system comprising: determining a terminating address (i.e., target number) for a terminating party to which a call is to be initiated (col. 6,lines 15-40); determining whether the terminating address (i.e., target number) should be used to directly initiate the call (col. 6,lines 15-40); when the terminating address (i.e., target number) should be used to directly initiate the call, directly initiating the communications with the terminal party using the terminating address (i.e., target number) (col. 12,lines 17-30); and sending the terminating address to a service node (e.g., MSC), which will facilitate an indirect call process using the terminating address to establish the call (i.e., using corresponding hairpin number) (col. 8,lines 10-38).

Regarding claim 18, Hirsbrunner further discloses in Fig. 1 a block diagram illustrated where selective hairpinning of a call through a communication network when the call is originated in another communication network can be implemented, in which network connectivity corresponds to facilitating communications with cellular network, local wireless network, wireless access point, LAN and PSTN.

Regarding claims 19, 36, they are method claims corresponding to the apparatus claims 1, 18 above. Therefore, claims 19, 36 are analyzed and rejected as previously discussed with respect to the claims 1, 18 above.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-3, 12-16 and 20-24, 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsbrunner et al. (US#6,999,770) in view of Goodman et al. (US#7,099,306).

With respect to claim 2, 12-16, the references disclose a novel system and method for routing calls based on the network supporting the telephony terminal, according to the essential features of the claims. Hirsbrunner et al. (US#6,999,770) discloses in Figs. 1-2 the block diagrams illustrated where selective hairpinning of a call through a communication network when the call is originated in another communication network can be implemented, and of a wireless communication unit arranged for facilitating selective hairpinning of a call in the system comprising: at least one communication interface; and a control system associated with the at least one communication interface (col. 5, line 25 to col. 6, line 8): determine a terminating address (i.e., target number) to which a call is to be initiated (col. 6, lines 15-40); determine whether the terminating address should be used to directly initiate the call (col. 12, lines 17-30); when the terminating address should be used to directly initiate the call, directly initiate the call using the terminating address (col. 12, lines 17-30); and send the terminating address to a service node, which will facilitate an indirect call process using the terminating address to establish the

call (i.e., determining whether to hairpin the call or not based on the terminating address) (col. 8, lines 10-38).

However, Hirsbrunner et al. (US#6,999,770) does not disclose expressly the current network connectivity available for the communications with the terminating party. In the same field of endeavor, Goodman et al. (US#7,099,306) teaches in Fig. 5 a flow diagram illustrated a method for executing a call using the stored telephony advertisement packets according to one embodiment of the present invention, in which a user attempts to initiate a call, step 502. The call attempt is based on call address information, such as an E.164 address or a SIP URL. To place the call, the VoIP sends a request over the network to an IP telephony gateway or similar service to perform call setup and address resolution. A check is performed to determine if the telephony gateway is available, step 504. Where the telephony gateway is available, the VoIP software utilizes the signaling services that the telephony gateway provides to place the call, step 506. The VoIP software queries the dynamic dial plan based on the call address information that the user supplies, step 508. The query may comprise any format that the dynamical dial plan supports. For example, where the dynamic dial plan is a relational database, the VoIP software may issue a SQL query based on the call address information. A check is performed to determine if the dynamic dial plan comprises the address information that the user supplies, step 510. For example, where the user supplies a SIP URL, the query determines if IP address information associated with the supplied SIP URL is in the dynamic dial plan. Where the dynamic dial plan does not comprise the address information, step 510, a call failure message is returned to the VoIP software, step 512, which may optionally be presented to the user. If, however, the address

information is in the dynamic dial plan, step 510, the data is returned from the dynamic dial plan, which is used by the VoIP software to initiate the call, step 514 (Col. 7, lines 40 plus).

Regarding claim 3, the mobile phone's telephone number/ISDN number (also known as its E.163/E.164 address) is an international public telecommunication numbering plan as defined in the International Telecommunication Union's international public telecommunication numbering plan, available at <http://www.itu.int/ITU-T/publications/index.html>. Also, the client device identifiers in SIP requests are known as SIP addresses. A user would initiate and receive a packet switched call using SIP, e.g. to initiate a packet switched call the user would enter the SIP address for the called party (e.g. john@(example.org), whilst he/she would initiate and receive a circuit switched call using the DTAP protocol.

Regarding claims 20-24, 30-34, they are method claims corresponding to the apparatus claims 2-3, 12-16 above. Therefore, claims 20-24, 30-34 are analyzed and rejected as previously discussed with respect to the claims 2-3, 12-16 above.

One skilled in the art of communications would recognize the need for facilitating communications over multiple networks utilizing the current network connectivity, and would apply Goodman's teaching of the current network connectivity available for the communications with the terminating party into Hirsbrunner's novel use of the hairpinning of calls. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to apply Goodman's system and method for internet protocol telephony advertisement protocol into Hirsbrunner's selective hairpinning of calls through another network with the motivation being to provide a system and method for initiating communications with a terminating party based on the currently available network connectivity.

10. Claims 1-36 of this application also conflict with the claims of Application No. 11/190,278 (US Pub #2007/0025333 A1). 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP. 822.

Allowable Subject Matter

11. Claims 4-11, 17 and 22-29, 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is an examiner's statement of reasons for the indication of allowable subject matter: The closest prior art of record fails to disclose or suggest wherein different formats of the terminating address correspond to different types of network connectivity, and to determine the terminating address, the control system is further adapted to: a) determine the network connectivity to use for the communications with the terminating party; and b) provide a select format of the terminating address from the different formats based on the network connectivity, wherein the select format of the terminating address is used to initiate the communications with the terminating party; wherein the at least one communication interface is adapted to facilitate a plurality of different types of network connectivity, and different

terminating addresses or different terminating address formats are used to initiate communications with the terminating party, the control system further adapted to determine the network connectivity to initiate communications with the terminating party and determine the terminating address by either: a) selecting one of a plurality of addresses associated with the terminating party as the terminating address based on the network connectivity, or b) modifying an address associated with the terminating party to use as the terminating address based on the network connectivity; wherein the control system is adapted to: a) support a plurality of originating IDs for a user; b) select one of the plurality of originating IDs to use in association with initiating the communications with the terminating party; c) determine the terminating address for the terminating party based on the one of the plurality of originating IDs as well as the network connectivity to the at least one communication network, as specifically recited in claims.

13. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Sylvain (US#2007/0025333) is cited to show the calling non-PSTN numbers via a mobile terminal.

The Boettger et al. (US#6,625,132) is cited to show the idle intersystem roaming determination and system reselection in a CDMA wireless communication system.

The Jain et al. (US#6,104,799) is cited to show the customer defined call setup.

The Sagi et al. (US#2004/0264410) is cited to show the method and apparatus for providing a communication unit with a handoff between networks.

The Brown et al. (US#2002/0080822) is cited to show the address defined session management over stateless communications channels.

The Breuckheimer et al. (US#6,496,508) is cited to show the communication system architecture and method of establishing a communication connection therein.

The Cable et al. (US#6,570,868) is cited to show the system and method for establishing a communication connection.

The Zabawskyj et al. (US#2004/0058709) is cited to show the method and system for international roaming and call bridging.

15. **THIS ACTION THIS ACTION IS MADE FINAL.** See MPEP ' 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Phan whose telephone number is (571) 272-3149. The examiner can normally be reached on Mon - Fri from 6:00 to 3:00.

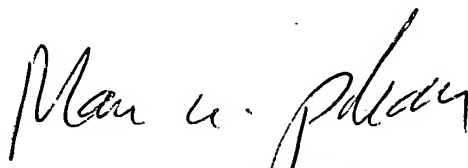
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel, can be reached on (571) 272-2988. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at toll free 1-866-217-9197.

Mphan

Jan. 15, 2008



MAN U. PHAN
PRIMARY EXAMINER